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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/172,553	10/14/1998	JAMES E. GREEN	2914.IUS	9441

7590 06/26/2003

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EXAMINER

DIAZ, JOSE R

ART UNIT	PAPER NUMBER
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2815

DATE MAILED: 06/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/172,553

Applicant(s)

GREEN ET AL.

Examiner

José R Díaz

Art Unit

2815

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 31-35 and 37-45.

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
10. ☐ Other: _____

EDDIE LEE
SUPERVISORY PATENT EXAMINER
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Continuation of 5. does NOT place the application in condition for allowance because: the prior arts anticipate the claimed invention. Applicant argued that the §112, first paragraph rejection is improper since the specification provides an adequate written description of the subject matter recited in claims 33, 34, 37-41, 44 and 45. However, the examiner disagrees. As stated before and now acknowledged by applicant in page 3 of the remarks, the written specification does not expressly state whether or not the HSG is left on or removed from the storage poly layer. In order to clarify this ambiguity and in accordance with the MPEP 2163 (second column in page 2100-164), the examiner relied on the drawings to understand how applicant provides support for the various features of the claimed invention. Please note that "[I]n those instances where a visual representation can flesh out words, drawings may be used in the same manner and with the same limitations as the specification." *Autogiro Co. of America V. United States*, 384 F.2d 391, 398, 155 USPQ 697, 703 (Ct. Cl. 1967). In the instance case, the drawings clearly show possession for a device in which the HSG (122, 130) is removed from the storage poly layer (see figures 7-10 and 20-21). Thus, applicant successfully showed possession for only one of the two previously identified embodiments or "possibilities." As an attempt to show possession for the second embodiment, applicant cited MPEP 2163.02: "[T]he subject matter of the claim need not be described literally (i.e., using the same terms or in haec verba) in order for the disclosure to satisfy the description requirement." However, such cited passage does not exempt applicant to provide support for each claimed limitation. As a matter of fact, MPEP 2163 (page 2100-162) states that "[W]hile there is no in haec verba requirement ... claim limitations must be supported..." Consequently, applicant fails to show possession of the claimed invention since nowhere in the specification, including the drawings, applicant provides support for a device in which the HSG is not removed from the storage poly layer. As such the rejection under 35 USC § 112, first paragraph is considered to be proper.

With regards to arguments against Woo et al., applicant is advised that during patent examination, the pending claims must be "given the broadest reasonable interpretation consistent with the specification" (see MPEP 2111). In the instance case, Woo et al. anticipate the claimed invention by showing the required storage electrode (30) (see figure 2) comprising mesas (18, 19, 23) (see figures 2, 6 and 8 and 10). With regards to the term "contiguous", and as stated on the Office action mailed June 25, applicant defines the term "contiguous" as structures that share a boundary. Woo et al. fulfills such definition by showing structures or mesas (18, 19, 23) sharing the same boundary or layer (16) (see figure 2, 6 and 8). With regards to the term "maze", applicant defined such term as "a confusing intricate network of passages." Woo et al. also fulfills the required definition by showing "a confusing intricate network of passages" formed between the mesas or structures (23) in figure 2. As such, the rejection under 35 USC § 102(b) is considered to be proper since Woo et al. discloses the claimed features.

With regards to arguments against Kenny, Applicant stated that Kenny does not teach a contiguous HSG layer in contact with the storage poly. As stated before, the broadest definition of the term "contiguous" only requires that the structure share a boundary. In the instance case, figure 4 clearly shows HSG (14) sharing the boundary or layer (10). Please note that is figure 4 and not figure 5, as argued, that show the HSG (14) in contact with the storage structure (10). Figure 5 is merely an alternate embodiment of the Kenny's invention. With regards to the term "confluent" (or confluence), the broadest definition only requires structures coming together or meeting at one point (see page 242 of Merriam-Webster's Collegiate Dictionary, 10, ed. 1998). As stated before, figure 4 clearly shows HSG (14) coming together or meeting at layer (10). With regards to arguments about the mask 16 of Kenny, please note that such mask (16) is "substantially" spaced from the poly structure (10) by the HSG (14) (see Figs. 2) and are positioned such that the recesses (20) in the storage poly structure (10) are exposed through said mask (16) (see Figs. 3 and 4). As such, the rejection under 35 USC § 102(b) is considered to be proper since Kenny discloses the claimed features.

With regards to arguments against Ahn, please note that the same rationale used in Kenny about the term "substantially confluent" also apply in Ahn. Thus, Ahn also anticipates the claimed limitation since Ahn shows a "substantially confluent" HSG (80) formed on the storage electrode (40,50) and a mask (70, 56) "substantially" spaced from the poly structure (40, 50) by the HSG (80) and positioned such that the recesses (space between the masks 70, 56) in the storage poly structure (40, 50) are exposed through said mask (70, 56) (see Figure 17). As such, the rejection under 35 USC § 102(b) is considered to be proper since Ahn discloses the claimed features.